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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,514	04/20/2006	Herbert Wolter	060953-0138	3740
22428	7590	08/18/2009	EXAMINER	
FOLEY AND LARDNER LLP			PRICE, ELVIS O	
SUITE 500			ART UNIT	PAPER NUMBER
3000 K STREET NW			1621	
WASHINGTON, DC 20007				
			MAIL DATE	DELIVERY MODE
			08/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/576,514	WOLTER, HERBERT	
	Examiner	Art Unit	
	ELVIS O. PRICE	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 April 2009.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-29 and 31-43 is/are pending in the application.
 4a) Of the above claim(s) 15-29 and 31-39 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-14 and 40-43 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date 4/20/06 and 4/4/07.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

DETAILED ACTION

1. Claims 1-29 and 31-43 are pending in the application.
2. Applicant's election with traverse of Group I (claims 1-14 and 40-43) in the reply filed on 4/24/09 is acknowledged. Claims 15-29 and 31-39 remain withdrawn from consideration as being drawn to non-elected inventions. The traversal is on the ground(s) that the inventions of Groups I and II have identical classification so a search of both groups would not be burdensome. This is not found persuasive because prior art anticipating and/or rendering obvious the invention of Group I would not necessarily anticipate or render obvious the invention of Group II. Therefore, it would be burdensome to search and prosecute both distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 9, 10, 40 and 41 are objected to because of the following informalities: Claims 9, 10, 40 and 41 recites language such as “in which Z' has the meaning...” or “in which b means...”. This language is not consistent with the language used to define the variables Z' and b. Perhaps applicants intended “in which Z' is...” and “in which b is...” Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation R' being 1 to 20 carbon atoms, and the claim also recites R' preferably being 1 to 4 carbon atoms, which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 8, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolter et al. {US Pat. 6,124,491}.

Wolter et al. disclose Silane compounds as defined by the present structure (1a) (see the methacrylate silane compounds in Examples 1, 3, 6 and 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 6, 7, 9, 11, 13, 14 and 40-43 rejected under 35 U.S.C. 103(a) as being unpatentable over Wolter et al. {US Pat. 6,124,491}.

Wolter et al. teach Silane compounds as presently claimed (see Silane compounds represented by formula (I) and Col. 2 through 21). The difference between the presently claimed silane compounds and what is taught by Wolter et al. is that Wolter et al. do not exemplify the specific silane compounds as recited in the present claims 6, 9, 11, 13, 14 and 40-43.

It would have been *prima facie* obvious to one having ordinary skill in the art, in view of Wolter et al., to arrive at the presently claimed silane compounds because Wolter et al. teach a range of silane compounds, represented by formula (I), which encompass the presently claimed silane compounds. One having ordinary skill in the art, desiring to arrive at other art recognizable silanes which can be hydrolyzed and/or polymerize to form polycondensates and polymerizes, would have been motivated to use any silane compound within the scope of the silane compounds taught by Wolter et al. Therefore, the presently claimed invention would have been obvious to one having ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELVIS O. PRICE whose telephone number is (571)272-0644. The examiner can normally be reached on 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached on 571 272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elvis O. Price/
Primary Examiner, Art Unit 1621